

REMARKS

Claims 1-16 were examined by the Office, and in the final Office Action of June 21, 2007 all claims are rejected. With this response claims 1-3 and 15 are amended, and claims 4-5, 14 and 16 are cancelled. Claim 1 is amended to include the limitations from cancelled claims 4 and 5, and claim 15 is amended to include the limitations from cancelled claim 16. All amendments are fully supported by the specification as originally filed. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following discussion.

This response is submitted along with a Request for Continued Examination (RCE).

Claim Rejections Under § 101

Applicant respectfully submits that the rejection of claim 14 is moot in light of the cancellation of claim 14.

Claim Rejections Under § 103

In section 3, on page 3 of the Office Action claims 1-3, 6 and 8-15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dutta et al. (U.S. Appl. Publ. No. 2002/0149569) in view of Will (U.S. Patent No. 6,392,640). Applicant respectfully submits that claim 1 is not disclosed or suggested by the cited references, either alone or in combination, because there is no motivation to combine the cited references, and therefore the cited references fail to disclose or suggest all of the limitations recited in claim 1. In addition, in order to further distinguish the patentable subject matter of claim 1 from the cited references, claim 1 is amended to include limitations from claims 4 and 5. The Office acknowledges on page 6 of the Office Action that Dutta does not teach adapting the contents of the database after at least one word has been selected, or that adapting the database is performed by adding a new word to the database, and relies upon Dostie (U.S. Appl. Publ. No. 2004/0021691) for this teaching. However, applicant respectfully submits that the combination of cited references do not disclose or suggest claim 1 as amended.

First, the Office acknowledges on page 3 of the Office Action that Dutta does not teach that the user interface is a roller, wherein browse commands are issued by rotating the roller around its axis, and select commands are issued by pressing the roller, as recited in claim 1. Applicant respectfully submits that there is no motivation or suggestion to combine the roller of

Will with the device disclosed in Dutta, because this combination would change the principle of operation of Dutta. See MPEP § 2143.01 (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious).

Dutta is directed to an improved touchscreen keyboard that facilitates greater speed and ease of user input. See Dutta paragraph [0007]. Characters are entered by using a stylus to select characters from the touchscreen keyboard. See Dutta paragraph [0025]. Based on the entered characters, the personal digital assistant discussed in Dutta predicts potential candidates for the next entry, and presents the predicted candidates to the user in a prominent fashion. See Dutta paragraphs [0056] & [0057]; see also Figure 7 & paragraph [0039]. By prominently displaying the predicted next characters, it is easier for a user to find the next character to select when using the touchscreen. Dutta is specifically directed to providing a customizable touchscreen keyboard in which the predicted next characters may be displayed on the customized touchscreen keyboard.

In response to applicant's previous arguments with respect to the combination of Dutta and Will, the Office asserts on page 7 of the Office Action that the motivation to combine Dutta and Will can be found in the references themselves. The Office fails to point out where in either Dutta or Will the motivation to combine the references can be found, and instead only asserts that there is no teaching in Dutta that prohibits the use of a thumbwheel or teaches that a thumbwheel would destroy Dutta's invention. Applicant respectfully submits that there is no requirement that a reference specifically teach away from a combination for there to be no motivation or suggestion to combine references. Instead, the question is whether one of skill in the art would be motivated based on the teachings of the references and the knowledge generally available to one of skill in the art to make the asserted combination and arrive at the limitations recited in the claim. However, as applicant previously stated, the addition of a thumbwheel to Dutta would destroy the purpose of Dutta of providing a customizable touchscreen keyboard for the selection of characters. The Office specifically states that Dutta is directed to an improved touch screen keyboard to facilitate greater speed and ease of use in small handheld devices. The Office recognizes that the purpose of Dutta is to facilitate greater speed and ease of use, but maintains that the addition of a thumbwheel to select the prominently displayed prediction candidates would not reduce the speed and ease of operation of the device and system discussed in Dutta.

If a thumbwheel were added to the teachings of Dutta, the thumbwheel would not increase the speed or ease of operation over what is already taught by Dutta, i.e. using a pointing device to select prominently displayed prediction candidates from a touchscreen keyboard. For example, if the prediction candidates were “A,” “E” and “O,” under the current teachings of Dutta the user would merely touch the desired prediction candidate using the pointing device, and that letter would be selected. However, if a thumbwheel is added, and the desired letter is “O” the user will have to manipulate the thumbwheel to scroll through “A” and then “E” in order to select “O.” This is because a thumbwheel only allows for incrementing or decreasing a selection tool relative to the previous location. Therefore, if the references are combined as suggested by the Office, the user can no longer directly select the desired letter, because the user may have to scroll through the prominently displayed prediction candidates to get to the desired letter. This destroys the purpose of Dutta, because the selection of letters has been made more complicated, and therefore one of skill in the art would not be motivated to combine the teachings of Dutta with those of Will.

Furthermore, the Office states that Will teaches that a character group may be displayed on a touch-sensitive screen and selected by the user touching the screen. See Will paragraph [0005]. However, simply because the system disclosed by Will provides for the use of a touchscreen and thumbwheel does not mean that the same is true for Dutta. The Office appears to apply the logic that one of skill in the art would be motivated to include a thumbwheel in the system of Dutta, because Will provides for both a thumbwheel and touchscreen. However, it is irrelevant that the system of Will may allow for both a thumbwheel and touchscreen, because the Office is modifying Dutta to include the thumbwheel as required by claim 1. Therefore, it must be shown that there is motivation to make this combination, and it is irrelevant that this combination may be supported by the system discussed in Will, because the systems discussed in Will and Dutta are very different.

The Office further asserts that it would be obvious to modify Dutta by the teachings of Will to enable a way of entering text in a device too small for a keyboard. However, Dutta specifically teaches a touchscreen keyboard, where prediction candidates are prominently displayed on the keyboard. Therefore, the devices intended for the system of Dutta already have sufficient space for at least a touchscreen keyboard. If the keyboard is eliminated from the system of Dutta in favor of a thumbwheel, as apparently asserted by the Office, then the system

of Dutta would become completely inoperative. This is because the system of Dutta is specifically directed to touchscreen keyboards. In addition, the Office asserts that the combined teachings of Dutta and Will provide a way to more effectively enter characters. However, contrary to the assertions of the Office, as pointed out above, the combined teachings would actually complicate character entry. Therefore, the motivation provided by the Office is completely incorrect with respect to the teachings of the cited references. Instead, applicant respectfully submits that the Office has combined the teachings of the cited references through the use of impermissible hindsight reasoning, and therefore there is no motivation or suggestion to combine the teachings of the cited references.

Second, with respect to the Office's arguments on page 9 of the Office Action that applicant is arguing against the references individually. Applicant acknowledges that one cannot show nonobviousness by attacking references individually. However, the Office had acknowledged that Dutta failed to disclose all of the limitations recited in claim 1, and asserted that the combination of Dutta and Will disclosed all of the limitations of claim 1. However, since there is no motivation to combine the cited references, the combination of references cannot disclose or suggest all of the limitations recited in claim 1. Therefore, applicant previously demonstrated that Will, by itself, cannot disclose or suggest all of the limitations recited in claim 1, since it is not proper to combine the teachings of Dutta and Will. Applicant reiterates that Will does not disclose or suggest all of the limitations recited in claim 1, for the following reasons.

The character recognition and selection system discussed in Will is entirely different from the method recited in claim 1. Claim 1 recites a character subset of a character set is generated, and the character subset includes characters from which the next character of a word is most probably selected. In contrast to claim 1, Will discloses that a user enters the first few letters of a word ambiguously, i.e. by selecting a "character group," and the system retrieves words consistent with the letters. See Will Abstract; column 4, line 66—column 5, line 1. Therefore, the user does not select a particular letter, but instead only a character group of letters of which include the desired letter. The system then proposes words that include combinations of letters that were within the character group. See Will column 6, lines 46-58. Therefore, Will fails to disclose or suggest generating a character subset of a character set that includes characters from among which the next character for a word is most probably selected, as recited in claim 1.

Instead, Will only generates a group of words that correspond to the ambiguously selected characters within the character groups. The words are not a character subset, as recited in claim 1, because the words are not a subset of any of the “character groups,” since they contain characters from each character group. Furthermore, the proposed words are not a character subset from which the next character of a word can be selected by a user, because the user of the system of Will can only select one of the entire words. Therefore, for at least these reasons, the cited references, alone or combination, fail to disclose or suggest all of the limitations recited in claim 1.

Finally, the Office acknowledges that Dutta and Will fail to disclose or suggest the limitations recited in claims 4 and 5, and relies upon Dostie for these teachings. Claim 1 is amended to include the limitations of claims 4 and 5 by reciting adapting contents of a database by adding a new word to the database after at least one word has been entered. The Office asserts that Dostie discloses adapting the database by adding a new word to the database on page 6 of the Office Action, but fails to provide any motivation for combining the teachings of Dostie with those of Dutta and Will. Therefore, since the Office has failed to provide the motivation for the combination, applicant respectfully submits that the Office has failed to establish a *prima facie* case of obviousness. As such, applicant respectfully requests withdrawal to the rejection of claim 1 as amended.

Independent claim 15 contains limitations similar to those recited in claim 1, and is amended to include the limitations recited in claim 16. Therefore, for at least the reasons discussed above in relation to claim 1, claim 15 is not disclosed or suggested by the cited references. In addition, the Office has failed to show provide any motivation for combining the cited references with respect to claim 16. Therefore, applicant respectfully requests withdrawal of the rejection to claim 15 in view of the amendment to claim 15.

The dependent claims depending from the independent claims discussed above are not disclosed or suggested by the cited references at least in view of their dependencies.

Conclusion

For at least the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

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